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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
60374.0040US02/CPOL 968020

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on _____

Signature _____

Typed or printed name _____

Application Number	Filed
10/010,270	December 6, 2001

First Named Inventor
Harold J. Plourde Jr.

Art Unit	Examiner
2421	Hoang Vu A Nguyen Ba

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record.
Registration number 47,034.

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

/David Rodack/
Signature

David Rodack
Typed or printed name

404.954.5049
Telephone number

August 17, 2010
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of 1 forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of: **Harold J. Plourde Jr.**	Confirmation No.: **5626**
Serial No.: **10/010,270**	Group Art Unit: **2421**
Filed: **December 6, 2001**	Examiner: **Hoang Vu A Nguyen Ba**
For: **Controlling Substantially Constant Buffer Capacity For Personal Video Recording With Consistent User Interface Of Available Disk Space**	Docket No.: **60374.0040US02/CPOL 968020**

REMARKS IN SUPPORT OF PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants submit the following remarks in support of a request for a pre-Appeal Brief Conference. Claims 1-3 and 5-47 are currently pending and subject to a final rejection per the final Office Action mailed on March 17, 2010. Of particular relevance to the present response, the final Office Action rejected independent claim 1 under 35 U.S.C. §103(a), and independent claim 24 under 35 U.S.C. §102(e). That is, independent claim 1 has been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent Application Publication No. 2002/0040475 to *Yap et al.* ("*Yap*"), and independent claims 24 has been rejected as allegedly anticipated by *Yap*. The final Office Action rejected other claims using at least the aforementioned grounds for rejection and *Yap*, but for purposes of the present response, Applicants address the rejection to claims 1 and 24 for purposes of pointing out errors of fact and law. Applicants respectfully traverse the rejections, and respectfully submit that there exist clear cases of error, supported by the evidence in the record, in these rejections.

REMARKS

1. Independent claim 1 - 35 U.S.C. §103(a)

As set forth on page 18 in the response to non-final Office Action (herein, "non-final OA response") dated January 6, 2010, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and hence submit that the rejection is based at least on an error at law. For instance, the rejection does not disclose, teach, or suggest a buffer space residing in a hard disk where there is a visual indication of available free space, the ***indication independent of the buffer space***. The final Office Action acknowledges (page 7) that "Yap does not explicitly disclose that the buffer space is in the hard disk," yet alleges in part the following (page 7):

> However, the decision of whether to locate the SDRAM 315 with buffer space 316 inside or separate from the hard disk HDD 320 (e.g., FIGs. 6, 8-9) is a matter of design choice, one of which may be the choice and the advantage of integrating the SDRAM with the HDD to help improve the compactness and reliability of the design.
>
> It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Yap by integrating the SDRAM with the HDD for the purpose discussed above.

As a preliminary note, the final Office Action (page 7) references figures 21a-e, 22a-c, and 23a-c for the visual indication of free space features. As noted on pages 18-19 of the non-final OA response, these figures are directed to the HDD 320, not SDRAM. Assuming *arguendo* that the SDRAM 315 can be incorporated into the HDD 320, then a *prima facie* case of obviousness still cannot be established (and hence an error in law) since it either (1) could not then be reasonably alleged that the indication of available free space is ***independent of the buffer space*** (in view of their alleged consolidation), or in the alternative, (2) it cannot be reasonably alleged that *Yap* is modified in a predictable manner (e.g., see page 3 of the final Office Action) as to whether buffer space and the disk space that allegedly encompasses the buffer space are independent in any ensuing free space indication. That is – how is the free space indication handled in view of any consolidation? There is no evidence or support for a buffer-independent indication after consolidation.

As a further error, it is noted that the contentions (page 7, final Office Action) that the SDRAM 315 can be integrated into the HDD 320 has not been established by the evidence on the record. The reference to para. 0254 of *Yap* on page 3 of the final Office Action merely discloses that the SDRAM can be consolidated into "a single SDRAM or other memory device," not that ***the*** SDRAM 315 with buffer space 316 can be consolidated ***specifically in the HDD***

320. It is further noted that claim 1 of *Yap* draws a distinction between a "memory device" like SDRAM and a "storage device" like the HDD (see claim 15). Even assuming *arguendo* that buffer space can be integrated in a hard disk (see, e.g., page 3 of the final Office Action and "well-known" allegation), that still does not mean that free space indication has a buffer space/ hard disk space independence.

The final Office Action further alleges in part (page 3) the following:

> In response to 2) i), it is respectfully noted that the features of having the buffer space being housed in the hard disk is, as discussed in the OA, deemed obvious because design incentives (or choices) or other market forces (more compact device) could have prompted one of ordinary skill in the art to modify Yap in a predictable manner (maintaining same inputs, same functions and same output results) to result in the claimed invention for compact design purposes. In *Dann v. Johnston*, the Court held that "[t]he gap between the prior art and respondent's system is simply not so great as to render the system nonobvious to one reasonably skilled in the art."

As set forth in the non-final OA response (pages 19-21), the allegation of design choice is not consistent with the teachings of *Yap*. For instance, the inventor in *Yap* appeared to make a conscious decision (based on the extensive citations to the process utilizing both) in *Yap* to use both the HDD and SDRAM as separate devices for downloading content, the latter (SDRAM) apparently serving to facilitate the control by host processor in routing content to the HDD 320 (see, e.g., paragraph [0176]). Again, even assuming *arguendo* the buffer space of SDRAM 315 can be integrated in the HDD 320, evidence of which is not established, that does not address the free space indication and its independence from the buffer space, but rather, suggests consolidation in a single GUI, and hence the rejection is based on an error in law in that a *prima facie* case of obviousness has not been established.

Further, as set forth in the non-final OA response (id), Applicants respectfully note that *Yap* does indeed appear to disclose a buffering mechanism in the HDD 320, and in particular, in the pause mechanism (for live broadcast) (see, e.g., para 0348). Further, as indicated in the non-final OA response (id), *Yap* also discloses in paragraph [0158] that the capacity appears to be distributed among the permanent recording space and the temporary space (pause function). Paragraph [0158] of *Yap* is reproduced in part discloses (emphasis added) that the "…HDD 320 may have a capacity of at least about 25 Gbytes, where preferably about at least 20 Gbytes is available for various recording applications, and the remainder flexibly allocated for pause applications in architecture 700." Given the fact that the pause space allocation in the HDD 320 is "flexibly allocated," and the 25 Gbytes capacity includes the 5 and 20 Gbyte portions, it is reasonable to assume that the free space indication includes both portions (are combined in, say, figure 21 of Yap) as well. If not combined, then the flexible allotment of 5 Gbytes of the

total 25 Gbytes does not match up visually (from a percentage perspective) to the figures (e.g., Figures 21a-c of *Yap*, which for instance, shows 100% as being less than the capacity represented by the full gauge). For instance, if the capacity is 25 Gbytes from which 5 Gbytes is set off for pause, then it makes no sense to consider the 20 Gbytes to be equivalent to the 0-100% and equate the pause to that area outside of the 0-100%, since 5 + 20 make-up the capacity. If the entire gauge is 25, then 20 + 5 portions would also lend support to a visual indication that includes both buffered and permanent space (and not independent).

Further, the rejection is based on an error in fact. The final Office Action (pages 2-3, emphasis added) further alleges in part the following:

> Furthermore, it should be noted that it is commonly known that the size of buffer space is predetermined (8 MB, 16, MB, etc.) and is always less than that of a hard disk (e.g., 20 GB, etc.) because the function of the buffer space is to temporarily store incoming data while the outcoming data is written to the hard disk which operates slower than the buffer space (RAM). Since this data transfer is transparent and irrelevant to a viewer for the assessment of available free space for recording programs which are to be stored on a permanent storage device such as a hard disk, there is no need to be[sic] monitor the available free space in a buffer space.
>
> It is respectfully considered that the claim element "such that the indication is independent of the buffer space" is included in the claim to merely avoid the teachings of the prior art because this feature is not believed to be an inventive novelty.

Applicants respectfully submit that the underlined contentions are contradicted by the evidence of record, and hence constitute an error in fact. For instance, the buffer space independence feature is indeed an intended, original (and not an "add-on" in view of the cited art) feature of the claims, as witnessed by its presence in the original filed claims (see, e.g., claim 1 as originally filed). Further, given that buffer space capacity is described on page 28 of the filed application as holding a considerable amount of content (e.g., 3-4 hours worth of content), and given that the buffered content is not transparent to the user as disclosed in Figures 20-22, the allegation of irrelevance is belied by Applicants' disclosure that buffered content is significant. Even the art of record (e.g., *Yap*) recognizes that buffered content is neither transparent nor irrelevant to the viewer, as noted by the reference to buffered live broadcast in the pause mode (see, e.g., para 0348, *Yap*). For at least the reasons that the rejection is based on errors in fact and law, Applicants respectfully request that the final rejection to claim 1 be withdrawn and the case re-opened for prosecution.

2. Independent claim 24- 35 U.S.C. §102(e)

The final Office Action (page 12) equates the buffer space to the SDRAM 315. However, the storage device, referenced in the preamble of claim 24 and in the body of the claim, includes a hard disk (As noted by the preamble). The SDRAM 315 of *Yap* does not. Claim 24 also requires buffering media content instances into buffer space of the storage device, and providing a visual indication of an amount of available free space of the storage device, such that the indication is independent of the buffer space. The final Office Action (page 5) further alleges that based on para. 0254 of *Yap*, "Yap indicates that buffer space SDRAM 315 can be consolidated into other memory device." The final Office Action (page 5) further continues, alleging that "this can be interpreted that SDRAM 315 can be part of HDD 320 which is considered to[sic] a memory device." Similar to the arguments set forth above, (1) assuming the SDRAM 315 could be integrated into the HDD 320, then Applicants respectfully submit that such an allegation either favors a consolidated gas disk gauge (as shown in Figure 21a-b of *Yap*), or in the alternative, fails to lead to predictability as to the buffer-independent free space indication, and (2) there is no evidence that the SDRAM 315 can be integrated into the HDD 320 (though each type of memory device and storage device may be embodied in other forms). Accordingly, as to (1) a prima facie case of obviousness has not been established with regard to the visual indication, buffer independence feature, resulting in an error in law, and as to (2) there is an error in fact. For at least these reasons, Applicants respectfully request that the rejection to claim 24 be withdrawn and the case re-opened for prosecution.

CONCLUSION

Favorable reconsideration and allowance, or the re-opening of prosecution on the merits, of the present application is hereby courteously requested.

Respectfully submitted,

Date: August 17, 2010

By: /David Rodack/
David Rodack, Reg. No. 47,034

Merchant & Gould
P.O. Box 2903
Minneapolis, Minnesota 55402-9946
Telephone: 404.954.5049